



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
4th & CONNISTEER FOR PATENTS  
700 Folsom  
Alexandria, Virginia 22304-1115  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/331,674	04/14/2000	ALAIN BRUGOT	Q54768	1947

7590 08/12/2003  
SUGHRUE MION ZINN MACPEAK & SEAS  
2100 PENNSYLVANIA AVENUE NW  
WASHINGTON, DC 20037-3212

EXAMINER

LEE, DIANE I

ART UNIT PAPER NUMBER

2876

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/331,674

Applicant(s)

BRUGOT ET AL.

Examiner

D. I. Lee

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 10 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-4, 6, 7 and 9 is/are rejected.
- 7) ☐ Claim(s) 5, 8 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Receipt is acknowledged of the Amendment filed 10 June 2003. Claims 1-4 and 9-10 have been amended; no claims have been canceled; and no claims have been newly added. Currently, claims 1-10 are pending in this application.

2. Acknowledgement is made of Applicant's confirmation of the Examiner's position in treating claim 9 as a dependent claim (see page 8, lines 9+ of the Amendment filed 10 June 2003).

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-4, 6-7, and 9 are remain rejected under 35 U.S.C. 103(a) as being unpatentable over Krietemeier et al. [US 4,763,928-referred as Krietemeier].

Re claims 1, 3-4, and 9: Krietemeier teaches an identification process having an image that includes at least one coded part undetectable by the naked eye which is capable of being read by a reading device (a detector or sensor, not shown, for reading the code with a predetermined placement or orientation with respect to the reading device), comprising:

Art Unit: 2876

generating numerical data corresponding to a particular coded information, such as an identification information including an owner-identifying coded data, manufacturer, model number, serial number, or etc. (see col. 8, lines 60+ and figure 10, step 82);

these numerical data are converted by a suitable device into a visually exploitable and transitory on screen image, e.g., the numerical data is stored in disc file as shown in step 84, transfer to magnetic tape as shown in step 86, and converted to a readable form as shown in step 88 prior to it is displayed on a small cathode ray tube as shown in step 90 (see col. 10, lines 11+ and figure 10 );

this image is transferred to a physical support (the display is then formatted and photographically reproduced and transferred onto a synthetic film, thus, the image is transferred to a support such as a microfilm by photocomposition) (see col. 9, lines 17+ and figure 10, step 92);

affixing (i.e., by apply backing adhesive) one or more images thus produced to the product or article to be marked (see col. 6, line 55-col. 7, line 29 for example);

reading the code with a matrix camera (not specifically shown) and storing them in memory (see figure 10, step 84);

wherein the text of the code undetectable by the naked eye of this image is presented in the form of a dot code (see col. 7, line 33+, 53+; col. 8, lines 35+; figure 5 for example)

Although the identification process obviously includes the reading the data and comparing the data with the stored information, Krietemeier is silent with respect the data generated in an algorithmic manner by a computer program and specific steps of reading during the identification and comparing by means of a consultation node.

Due to the fact that Krietemeier teaches the process of generating numerical data corresponding to a particular, and this generating process is obviously done by a computer program, which is a software having a coded instruction or procedure to execute a specific command having a logic; this obviously teaches that the computer program having an algorithmic logic. Further, Krietemeier shows the step of

Art Unit: 2876

identifying the article as designated at 52 in figure 6, which obviously teaches that the identification and comparing operation are performed a specific point of operation (i.e., by a means of a consultation node).

Accordingly, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to recognized that the data would have been generated in a algorithmic manner by a computer program in order to carry out the operations in sequence and the identification/comparing operation are performed a specific designated point of operation in order to facilitate the identification service.

Re claim 2: wherein the device converting numerical data into image exploitable visually on a cathode screen is an apparatus used to produce microforms as computer output (see col. 8, lines 50+); and

Re claim 6: the physical support is constituted by the product to be marked (see col. 2, lines 20+ and col. 3, lines 21+).

Re claim 7: the fact that the micro-identifier contains owner-identifying encoded data and is selected combination of serial number, dot pattern, or owner's name. Therefore, the identifier can be variable and non-variable (i.e., identical to one another or identical on each image) (see col. 4, lines 6+

#### ***Allowable Subject Matter***

6. Claims 5, 8, and 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: the best prior art of the record, Krietemeier fails to teach the specific steps of transferring the code as tone on tone to the support, placing a mask in from of the cathode screen at least one of the visible parts of the label, and fitting of the image is replaced by the use of the latter as a mask to engrave the product to be marked, as set forth in the claims.

*Response to Arguments*

8. Applicant's arguments filed 10 June 2003 have been fully considered but they are not persuasive.

9. In response to applicant's argument with respect to Krietemeier does not teach all that the examiner says it teaches, e.g., Krietemeier teaches micro-identifiers containing owner-identifying encoded data identical to the one another, and the present invention is directed to a process for manufacturing images that are all different from one another (see page 11, lines 1+); the examiner respectfully disagrees. Krietemeier teaches the each film 20 is prepared to identify each individual owners and each film 20 includes a plurality of micro-identifiers containing owner-identifying encoded data identical to the one another, and since Krietemeier is not limited only one owner and each film sheet is for one owner, therefore, the examiner interpreted that each individual film sheets are different from one another, i.e., each individual owners are different from one another.

10. The applicant stated that the present claims reciting a computer program generating numerical data corresponding to a particular text, while the examiner indicates that Krietemeier teaches the generation of numerical data, and applicant further stated that the digital information in Krietemeier does not teach or suggest the numerical data of the present invention (see page 11, lines 8+); the examiner respectfully disagrees. Krietemeier teaches that the particular text coded information, such as an identification information including an owner-identifying coded data, manufacturer, model number, serial number, or etc. are converted or transformed into numerical data (see col. 8, lines 60+ and figure 10, step 82) and these numerical data are converted by a suitable device into a visually exploitable and transitory on screen image, e.g., the numerical data is stored in disc file in step 84, transfer to magnetic tape in step 86, and converted to a readable form in step 88 prior to it is displayed on a small cathode ray tube in step 90 (see col. 10, lines 11+ and figure 10 ). Since applicant has not clearly defined how the numerical data are converted in the claim, given the broadest interpretation of the claim, the Krietemeier meets the claim limitation.

Art Unit: 2876

*Conclusion*

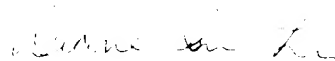
11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is 703-306-3427. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



D. I. Lee  
Primary Examiner  
Art Unit 2876

August 6, 2003